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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,655	07/20/2001	John E. Liebendorfer	2164.004	2619

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EXAMINER

KING, ANITA M

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 12/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

Applicant(s)

09/910,655

LIEBENDORFER, JOHN E.

Examiner

Art Unit

Anita M. King

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 7, 9, 10, 16, 17 and 19 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 8, 11-15, 18 and 20-23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

This is the second office action for application number 09/910,655, System for Removably and Adjustably Mounting a Device on a Surface, filed on July 20, 2001.

### ***Election/Restrictions***

Claims 24-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5. The examiner assumes that the nonelection of claims 24-30 was made without traverse because no arguments were presented in the Remarks section of applicant's response.

Claims 1-23 will be examined in this case. The arguments presented by applicant in Paper No. 5 dated August 26, 2002 regarding the restriction requirement between Group I (claims 1-9) and Group II (claims 10-23), are deemed persuasive.

### ***Drawings***

The drawings are objected to because reference number "18" in Fig. 4 appears to be incorrect and should be --18a--; reference number "18" in Fig. 6 appears to be incorrect and should be --18b--; and in Fig. 11, reference numbers "60" and "70" appear to be referring to the same element. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. •

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

description: "28b" and "48". A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: "48a," in Fig. 10 and "54a" and "54b" in Fig. 8. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: reference number "10" is used for a "system for adjustably mounting a device" on page 8, lines 11-12 and a "surface" on page 8, line 13, it is not understood as to which element reference number "10" is representing in the specification; on page 8, lines 16, 17, 19, and 23, "14a,b" should be changed to --14a, 14b--; on page 8, line 17 and 19, "16a,b" should be changed to --16a, 16b--; on page 8, line 19, "a8" should be changed to --18a, 18b-- for consistency; "28a,b" on page 8, line 28 should be changed to --28a, 28b--; "30a,b" on page 8, line 9 should be changed to --30a, 30b--; and "32a,b" on page 9, line 4 should be changed to --32a, 32b--.

Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the terminology of “a leading surface” and “a following surface” in claim 21 is not provided for in the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the recitation of “a second channel” in line 2 is indefinite, this limitation would imply that a first channel has been previously claimed and claims 10 and 12 from which claim 16 depends does not cite a first channel.

Claim 19 recites the limitation “the second channel” bridging lines 2 and 3 and “the first channel” in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6, 7, 9, 10, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,571,338 to Kadonome et al., hereinafter, Kadonome. Kadonome discloses a system for removably and adjustably mounting a device on a surface (30), comprising a rail (20) formed with at least two tracks (26); one or more clamps (50, 160, or 260) for connecting the system to the surface; wherein the at least two tracks include a channel the length of the rail; wherein the channel in the at least two tracks is formed with a slot extending the length of the rail; wherein the one or more clamps is formed as a duct with at least two opposing shoulders; wherein the opposing shoulders of the one or more clamps are substantially perpendicular to one another; and wherein the one or more clamps include means for connecting the device to the rail.

Kadonome further discloses an apparatus for positioning a module (30) on a surface, comprising: a footing grid, wherein the footing grid includes at least one keeper (41); the at least one dual track removably mountable on the footing grid; one or more clamps variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid.

Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,336,413 to Tourneux. Tourneux discloses an apparatus for positioning a module (11) on a surface, comprising: a footing grid (73), wherein the footing grid includes at least one keeper (72); at least one dual track (24) removably mountable on the footing grid; one or more clamps (70) variably positionable on the dual track rail and footing grid for demountably securing the module to the footing grid; and wherein the one or more

clamps is formed with a plate and monolithic opposing side walls extending substantially in the same direction at substantially right angles from the plate (Figs. 19 and 20).

### ***Allowable Subject Matter***

Claims 4, 5, 8, 11-15, 18, and 20-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16 and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 4,393,859 to Marossy et al.

U.S. Patent 4,636,577 to Peterpaul

U.S. Patent 5,232,518 to Nath et al.

U.S. Patent 5,367,843 to Hirai et al.

U.S. Patent 5,394,664 to Nowell

U.S. Patent 5,409,549 to Mori

U.S. Patent 5,787,653 to Sakai et al.

U.S. Patent 6,269,596 to Ohtsuka et al.


U.S. Patent 6,370,828 to Genschorek

The above patents all disclose various types of mounting systems for solar panels.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-3597 for regular communications and (703) 308-3519 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.

  
Anita M. King  
Primary Examiner  
Art Unit 3632

December 2, 2002